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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,780	01/22/2001	Michael J. Sullivan	P-5686U1-D1 SLD 2	8351
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THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED SUBSIDIARY OF CALLAWAY GOLF COMPANY P.O. BOX 901 425 MEADOW STREET CHICOPEE, MA 01021-0901			EXAMINER GORDON, RAEANN	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/766,780

Applicant(s)

SULLIVAN ET AL.

Examiner

Raeann Gorden

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a) because they fail to show a multiplayer cover as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance. Compare figures 3 and 4 with spec page 40.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose a cover "consisting" of a single cover layer.

***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamagishi (5,688,595). Regarding claim 1, Yamagishi discloses a golf ball comprising a dual core and a single outer cover. The dual core comprises a center component (12) and a core layer (13) (fig 2). The center component is made from a thermoset material and the core layer is made from a thermoplastic. The outer cover layer has a Shore D hardness from 40 to 60. Regarding claims 2, 4, and 6, the thermoset material for the core component is a polybutadiene and the thermoplastic material for the core layer is an ionomer. Regarding claim 3, the core may comprise of at least two layers (col 2, lines 57-60). Regarding claim 7, the center component has a diameter from 0.787 to 1.535 inches and the core component and core layer has a diameter from 1.378 to 1.614 inches. Regarding claims 8 and 9, Yamagishi discloses a variety of inert fillers that may be added to the core layers that are commonly known for increasing/decreasing density (col 5, lines 1-9).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi et al (5,688,595) in view of Maruko et al (5,752,888) or Maruko (5,792, 009), each. Regarding claim 10, Yamagishi discloses a golf ball comprising a dual core and a single outer cover. The dual core comprises a center component (12) and a core layer (13) (fig 2). The center component is made from a thermoset material and the core layer is made from a thermoplastic. The outer cover layer has a Shore D hardness from 40 to 60. Yamagishi does not disclose an inner cover layer with a Shore D hardness greater than 60 or more as in claim 10. Maruko '888 teaches an inner cover layer with a Shore D hardness greater than 60 and an outer cover layer Shore D hardness from 43 to 53. Maruko '009 teaches an inner cover layer with a Shore D hardness from 60 to 65 and an outer cover layer Shore D hardness from 43 to 53 (col. 4, lines 22-27). Regarding claim 11, 13, and 15, the thermoset material for the core component is a polybutadiene and the thermoplastic material for the core layer is an ionomer. Regarding claim 12, the core may comprise of at least two layers (col 2, lines 57-60). Regarding claim 16, the center component has a diameter from 0.787 to 1.535 inches and the core component and core layer have a diameter from 1.378 to 1.614 inches. Regarding claims 17 and 18, Yamagishi discloses a variety of inert fillers that may be added to the core layers that are commonly known for increasing/decreasing density (col 5, lines 1-9). One skilled in the art would have modified Yamagishi in view of Maruko '888 and '009 to increase initial velocity and ensures good spin and feel upon impact (Maruko '888 col 4, lines 8-13).

Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamagishi (5,688,595) in view of Maruko '888 or Maruko '009 as applied to claims 1-4, 6-13 and 15-18 above and in further view of Wu (5,334,673). Yamagishi in view of Maruko discloses the invention as shown above but does not include polyurethane as an option for the thermoset material (core component). However, Wu teaches a polyurethane golf ball product suitable for the core layer. One skilled in the art would have modified Yamagishi in view of Maruko by including a polyurethane core component to improve the resiliency of the golf ball.

### ***Response to Arguments***

The drawing objection is maintained. It is not understood why applicant continues to argue a multi-layer cover is shown in figures 3 and 4. Applicant's specification, lines 23-24, clearly discloses a core (30), a core layer (32), and a multi-layer cover (34). However, the figures do not display a multi-layer cover. Applicant is required to amend the drawing to coincide with the specification.

The 35 USC 112, first paragraph rejection is maintained. Again, applicant's disclosure does not support a single cover layer. Applicant cites pages 3 and 4 for support but a "single cover layer" is not disclosed. Applicant argues the term "conventional cover layer" includes a single cover layer. The Examiner disagrees. Applicant is well aware that "conventional cover layer" is not defined in the specification as a single cover layer and therefore cannot be given any arbitrary definition to overcome prior art. The rejection is maintained.

Applicant's arguments with respect to claims 1-18 have been considered but are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a golf ball comprising an inner cover layer harder than the outer cover layer is well established and known in the art. The hard inner cover layer provides high initial velocity and the soft outer cover layer ensures good spin and feel upon impact (Maruko col 4, lines 8-13). In response to applicant's argument that the Wu reference is directed to a polyurethane cover applicant's attention is directed to column 2, lines 33-39. Wu teaches the polyurethane golf product is suitable for cores and cover layers.

### **Conclusion**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Raeann Gordon  
Examiner  
Art Unit 3711

rg  
April 15, 2004